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Brian J. Brown

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HEWLETT-PACKARD COMPANY

Intellectual Property Administration

P.O. Box 272400

Fort Collins, CO 80527-2400

EXAMINER

SALL, EL HADJI MALICK

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/954,796

Filing Date: September 10, 2001

Appellant(s): Brown et al.

David R. Risley (Registration No. 39,345)

For Appellant

EXAMINER'S ANSWER

1. This is in response to the appeal brief filed November 21, 2005 appealing from the Office action mailed June 22, 2005.

REAL PARTY IN INTEREST

2. The appellants' statement of the real party in interest contained in the brief is correct.

RELATED APPEALS AND INTERFERENCES

3. The appellants' statement of the related appeals and interferences contained in the brief is correct.

STATUS OF THE CLAIMS

4. The appellants' statement of the status of the claims contained in the brief is correct.

STATUS OF AMENDMENT

5. The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

SUMMARY OF INVENTION

6. The summary of invention contained in the brief is correct.

ISSUES

7. The appellants' statement of the issues contained in the brief is correct.

GROUPING OF THE CLAIMS

8. The appellants' statement of the grouping of the claims in the brief is correct.

CLAIMS APPEALED

9. The copy of the appealed claims contained in the appendix pages 22-29 is correct.

PRIOR ART OF RECORD

10. Pat et al. U.S. Patent Number 6,353,926, issued on March 5, 2002, but filed on July 15, 11998.

Bradford U.S. Patent Number 6,678,679, issued on January 13, 2004, but filed on October 10, 2000.

Kroening U.S. Patent Number 6,859,924, issued on February 22, 2005, but filed on December 12, 2000.

Himmel et al. U.S. Patent Number 6,742,052, issued on May 25, 2004, but filed on August 9, 2001

NEW PRIOR ART

11. No new prior art has been applied in this examiner's answer.

GROUND OF REJECTION

The following ground(s) of rejection are applicable to the appealed claims:

12. Claims 1, 4-5, 7-12, 14-20 and 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Parthesarathy et al. (referred to as hereafter Pat) U.S. 6,353,926.

Pat teaches the invention as claimed including software update notification (see abstract).

As to claim 1, Pat teaches a method for distributing software, comprising:

Querying a user as to the needs of the user (column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new software update (i.e. loading the new software update is a "need" in that it allows incremental bug fixes, which the user "needs" for better machine performance));

receiving user responses to the query (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step);

characterizing the use of the user based upon the user responses (column 11, lines 14-15, Pat discloses the user indicates a desire to load the new software update); and

providing software programs that may be beneficial to the user based upon the characterization of the use (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer (i.e. the software update of the user's computer is inherently "beneficial to the user" because updates include patches)).

As to claim 4, Pat teaches the method of claim 1, wherein querying a user comprises querying the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 5, Pat teaches method of claim 1, further comprising receiving user selections in response to the provided software programs (column 4, lines 16-19, Pat discloses the application program is a set of software that performs a task desired by the user, making use of computer resources made available through the operating system; see abstract).

As to claim 7, Pat teaches the method of claim 5, further comprising initiating downloading of the selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 8, Pat teaches the method of claim 7, wherein the software programs are downloaded from a storage medium read by the computing device (column 2, lines 63-65, Pat discloses in a distributed computing environment, program modules may be located in both local and remote memory storage devices).

As to claim 9, Pat teaches the method of claim 7, wherein the software programs are downloaded to the computing device from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 10, Pat teaches system for distributing software, comprising:
means for querying a user as to the needs of the user (column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new

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software update (i.e. loading the new software update is a “need” in that it allows incremental bug fixes, which the user “needs” for better machine performance));

means for receiving user responses to the query (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step);

means for characterizing the use of the user based upon the user responses (column 11, lines 14-15, Pat discloses the user indicates a desire to load the new software update); and

means for providing software programs that may be beneficial to the user based upon the characterization of the use (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer (i.e. the software update of the user's computer is inherently “beneficial to the user” because updates include patches)).

As to claim 11, Pat teaches the system of claim 10, wherein the means for querying the user comprise means for querying the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 12, Pat teaches the system of claim 10, further comprising means for receiving user selections in response to the provided software programs (column 4, lines 16-19, Pat discloses the application program is a set of software that performs a

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task desired by the user, making use of computer resources made available through the operating system; see abstract).

As to claim 14, Pat teaches the system of claim 12, further comprising means for initiating downloading of the selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 15, Pat teaches the system of claim 13, wherein the means for initiating downloading comprise means for initiating downloading from a storage medium read by the computing device (column 2, lines 63-65, Pat discloses in a distributed computing environment, program modules may be located in both local and remote memory storage devices).

As to claim 16, Pat teaches the system of claim 13, wherein the means for initiating downloading comprise means for initiating downloading from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 17, Pat teaches a software program stored on a computer-readable medium, comprising:

logic configured to query a user as to the needs of the user (column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new software update (i.e. loading the new software update is a "need" in that it allows incremental bug fixes, which the user "needs" for better machine performance));

logic configured to receive user responses to the query (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step);

logic configured to characterize the use of the user based upon the user responses (column 11, lines 14-15, Pat discloses the user indicates a desire to load the new software update); and

logic configured to provide software programs that may be beneficial to the user based upon the characterization of the use (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer (i.e. the software update of the user's computer is inherently "beneficial to the user" because updates include patches)).

As to claim 18, Pat teaches the software program of claim 17, further comprising logic configured to receive user selections in response to the provided software programs (column 4, lines 16-19, Pat discloses the application program is a set of

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software that performs a task desired by the user, making use of computer resources made available through the operating system; see abstract).

As to claim 20, Pat teaches the software program of claim 17, further comprising logic configured to initiate downloading of the selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 25, Pat teaches a method for distributing software, comprising:
querying a user as to what the users wants to accomplish (column 6, lines 15-20, Pat discloses the computer queries the user to determine if the user wants to load the new update now or later (i.e. determining if the user wants to load the new update now or later can be equated to "what the user wants to accomplish"))).

receiving responses from the user (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step); and

providing software programs based upon the user responses (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer; column 11, lines 13-15, Pat discloses the installed software is performed when, in response to the querying step, and the user

indicates a desire to load the new software update (i.e. the new update is based on the user's desire that is inherently equivalent to "providing the software program based upon the user responses"))).

As to claim 26, Pat teaches the method of claim 25, wherein querying a user comprises querying the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 27, Pat teaches the method of claim 25, further comprising initiating downloading of selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 28, Pat teaches the method of claim 25, wherein the software programs are downloaded to a computing device from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 29, Pat teaches a method for distributing software, comprising:

querying a user as to the needs of the user (column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new software update (i.e. loading the new software update is a “need” in that it allows incremental bug fixes, which the user “needs” for better machine performance));

receiving responses from the user (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step); and

suggesting software programs based upon the user responses (column 2, lines 16-21, Pat discloses the channel is updated periodically based on the schedule suggested by the channel. when a new update is detected, the software channel delivers the software update to the user's computer (i.e. the software update of the user's computer is inherently “beneficial to the user” because updates include patches, therefore programs are implicitly suggested for download)).

As to claim 30, Pat teaches the method of claim 29, wherein querying a user comprises querying the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 31, Pat teaches the method of claim 29, further comprising initiating downloading of selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 32, Pat teaches the method of claim 29, wherein the software programs are downloaded to a computing device from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 33, Pat teaches a method for distributing software, comprising:
determining tasks a user wishes to accomplish from responses provided by the user (column 11, lines 11-14, Pat discloses querying the user to determine whether the user desires to load the new software update, and the installed software is performed when, in response to the querying step; column 6, lines 15-20); and

installing software programs based upon the determination (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer; column 11, lines 11-14, Pat discloses the installed software is performed when, in response to the querying step).

As to claim 34, Pat teaches the method of claim 33, wherein the responses are received in reply to queries posed to the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 35, Pat teaches the method of claim 33, further comprising initiating downloading of selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 36, Pat teaches the method of claim 33, wherein the software programs are downloaded to a computing device from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claims 38, 40 and 42, Pat teaches the method of claim 1, wherein providing software programs comprises automatically installing the software programs to a

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device of the user without selection of the software programs by the user (column 6, lines 52-54; column 31-32).

4. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 37, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable Pat U.S. 6,353,926 in view of Bradford U.S. 6,678,679.

Pat teaches the invention substantially as claimed including software update notification (see abstract).

As to claims 2, 37, 39 and 41, Pat teaches the method of claim 1.

Pat fails to teach explicitly querying a user comprises posing at least one multiple choice question to the user; and a series of questions to the user such that multiple questions are asked of the user.

However, Bradford teaches method and system for facilitating the refinement of data queries. Bradford teaches querying a user comprises posing at least one multiple choice question to the user; and a series of questions to the user such that multiple questions are asked of the user (column 13, lines 43-45, Bradford discloses the word under consideration may be incorporated into a question that is directly asked of the user; column 16, lines 52-53, Bradford discloses the user is presented with specific questions to refine the query).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Bradford to provide querying a user comprises posing at least one multiple choice question to the user; and a series of questions to the user such that multiple questions are asked of the user. One would be motivated to do so to allow user feedback regarding relevancy of retrieved data (abstract).

6. Claims 6, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat U.S. 6,353,926 in view of Kroening U.S. 6,859,924.

Pat teaches the invention substantially as claimed including software update notification (see abstract).

As to claims 6, 13 and 19, Pat teaches the method, the system and the software program of claims 5, 12 and 18.

Pat fails to teach explicitly suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses.

However, Kroening teaches an alternative method of selecting software to download (column 7, line 51 to column 8, line 21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Kroening to provide suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses. One would be motivated to do so to allow the proper software update.

7. Claims 3 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable Pat U.S. 6,353,926 in view of Himmel et al. U.S. 6,742,052.

Pat teaches the invention substantially as claimed including software update notification (see abstract).

As to claim 3, Pat teaches the method of claim 1.

Pat fails to teach explicitly querying the user as to how the user plans to use a peripheral device.

However, Himmel teaches wireless system bus. Himmel teaches querying the user as to how the user plans to use a peripheral device (column 2, line 66 to column 3, line 2, Himmel discloses querying the user whether to accept and configure the peripheral device (i.e. by querying the user whether to accept, user is inherently being "queried as to "how the user plans to use a peripheral device").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Himmel to provide querying the user as to how the user plans to use a peripheral device. One would be motivated to do so to allow the peripheral device to process data properly.

As to claim 21, Pat teaches the method for distributing software for a peripheral device, comprising:

querying a user as to what the users wants to accomplish (column 6, lines 15-20, Pat discloses the computer queries the user to determine if the user wants to load the new update now or later (i.e. determining if the user wants to load the new update now or later can be equated to "what the user wants to accomplish"));

receiving responses from the user (column 11, lines 13-14, Pat discloses the installed software is performed when, in response to the querying step);

providing software programs based upon the user responses (column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the

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software update to the user's computer; column 11, lines 13-15, Pat discloses the installed software is performed when, in response to the querying step, and the user indicates a desire to load the new software update (i.e. the new update is based on the user's desire that is inherently equivalent to "providing the software program based upon the user responses"))).

Pat fails to teach explicitly querying a user as to what the peripheral device may be used for; and providing software programs for the peripheral device based upon the user responses.

However, Himmel teaches querying the user whether to accept, and providing software programs for the peripheral device based upon the user responses (column 2, line 66 to column 3, line 2, Himmel discloses querying the user whether to accept and configure the peripheral device (i.e. by querying the user whether to accept, user is being "queried as to what peripheral device may be used for, and by configuring the peripheral device, "software programs are being provided or downloaded to the peripheral device"))).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Himmel to provide querying a user as to what the peripheral device may be used for; and providing software programs for the peripheral device based upon the user responses. One would be motivated to do so to allow the peripheral device to process data properly.

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As to claim 22, Pat teaches the method of claim 21, wherein querying a user comprises querying the user via a web site accessible on the Internet (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 23, Pat teaches the method of claim 21, further comprising initiating downloading of selected software programs to a computing device of the user (column 1, lines 35-40, Pat discloses because different types of computer hardware and operating systems can connect to a common network, software, software distributed over the network can be made to work across platforms or intelligent so that only the correct version of platform-specific software is pushed down to the user).

As to claim 24, Pat teaches the method of claim 21, wherein the software programs are downloaded to the computing device from a remote source via a network (column 1, lines 11-14, Pat discloses more and more individuals are acquiring software by downloading it from remote server computers connected to the client computers through the Internet).

As to claim 44, Pat teaches the method of claim 21, wherein providing software programs comprises automatically installing the software programs to a device of the

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user without selection of the software programs by the user (column 6, lines 52-54; column 31-32).

8. Claims 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pat U.S. 6,353,926 in view of Himmel et al. U.S. 6,742,052, and further in view of Bradford U.S. 6,678,679.

Pat teaches the invention substantially as claimed including software update notification (see abstract).

As to claim 43, Pat teaches the method of claim 21.

Pat fails to teach explicitly querying a user comprises posing a series of questions to the user such that multiple questions are asked of the user.

However, Bradford teaches method and system for facilitating the refinement of data queries. Bradford teaches querying a user comprises posing a series of questions to the user such that multiple questions are asked of the user (column 13, lines 43-45, Bradford discloses the word under consideration may be incorporated into a question that is directly asked of the user; column 16, lines 52-53, Bradford discloses the user is presented with specific questions to refine the query).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Bradford to provide querying a user comprises posing

a series of questions to the user such that multiple questions are asked of the user.
One would be motivated to do so to allow user feedback regarding relevancy of retrieved data (abstract).

5. *Response to Arguments*

The Examiner summarizes the various points raised by the appellant and addresses replies individually.

(A) As per appellant's argument filed on April 3, 2006, the applicant argues on page 10, lines 20-23, on page 11, lines 1-6 and lines 21-23, on page 13, lines 15-20 and on page 14, lines 9-15 of the brief on appeal that in regard to this claim, Applicant notes that Pat does not teach or suggest "characterizing the use of the user based upon the user responses" or "providing software programs that may be beneficial to the user based upon the characterization of the use", as recited in claims 1. Instead, the Pat method simply comprises loading the update if the user provides permission, and not loading the update if the user does not provide that permission. Pat says nothing about "characterizing the use" of the user based upon user responses. In fact, Pat's system and method do not "characterize" any use of the user. Further, Applicant notes that Pat does not teach or suggest "querying a user as to the needs of the user".

In regards to point (A), examiner respectfully disagrees.

The examiner kindly submits that the applicant(s) misread the applied references used in the rejection. Actually, applicants are interpreting the claims very narrow by considering the broad teaching of the references used in the rejection. The aforementioned assertion wherein Pat fails to teach applicant's claimed features as recited above, was unsupported by objective factual evidence and was not found to be of substantial evidential value. For example, Pat teaches querying the user to determine whether the user desires to load the new software, wherein said updating of the installed software is performed when, in response to the querying step, the user indicates a desire to load the new software update (column 11, lines 11-15). Moreover, Pat teaches providing or delivering software update to the computer when a new software is detected (column 2, lines 17-21). For this assertion to have merit, it is important to applicants provide some forms of evidence that convincingly show that examiner's references do not meet the claims language. Furthermore, Applicants are reminded that 37 CFR 1.111(b) states, "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section". Thus, applicants' assertions are just mere allegation with no supported fact by failing to specifically point out how the language of the claims patentably distinguished them from the cited references. For example "characterizing a use". Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the

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possibility that the claim, once issued, will be interpreted more broadly than is justified.

In re Prater 162 USPQ 541, 550-51 (CCPA 1969). Hence the 35 U.S.C 102 is hereby sustained.

Column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new software update (i.e. loading the new software update is a "need" in that it allows incremental bug fixes, which the user "needs" for better machine performance).

Column 6, lines 15-21, Pat discloses the computer then queries the user to determine if the user wants to load the new update now in step 112. If the user does not want to load the new update, the computer can then inquire if the user may want to load the update in the future. The users' responses are whether he wants to load the update now, later or never. In these steps Pat teaches analyzing (i.e. "characterizing" (i.e. as defined by www.answers.com: characterization is a rather long and fancy word for analyzing a system or process and measuring its "characteristics")) "the use of the user" in order to determine whether the user wants to load the new update now, later or never.

Column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user's computer (i.e. the software update of the user's computer is inherently "beneficial to the user" because updates include patches, which is "beneficial to the user").

(B) The appellant argues on page 12, lines 18-23 of the brief on appeal that in reference to claim 10, Pat fails to teach or suggest “means for querying a user as to the needs of the user”, “means for characterizing the use of the user based upon the user responses”, or “means for providing software programs that may be beneficial to the user based upon the characterization of the use” for reasons described above. For at least those reasons, Pat does not anticipate claim 10 or any of its dependents.

In regards to point (B), examiner respectfully disagrees.

Column 11, lines 11-12, Pat discloses querying the user to determine whether the user desires to load the new software update (i.e. loading the new software update is a “need” in that it allows incremental bug fixes, which the user “needs” for better machine performance).

Column 6, lines 15-21, Pat discloses the computer then queries the user to determine if the user wants to load the new update now in step 112. If the user does not want to load the new update, the computer can then inquire if the user may want to load the update in the future. The users’ responses are whether he wants to load the update now, later or never. In these steps Pat teaches analyzing (i.e. “characterizing” (i.e. as defined by www.answers.com: characterization is a rather long and fancy word for analyzing a system or process and measuring its “characteristics”)) “the use of the user” in order to determine whether the user wants to load the new update now, later or never.

Column 2, lines 17-21, Pat discloses when a new update is detected, the software channel delivers the software update to the user’s computer (i.e. the software

update of the user's computer is inherently "beneficial to the user" because updates include patches, which is "beneficial to the user").

In Figures 3 and 5, Pat discloses the means to perfume the above claimed invention.

(C) The appellant argues on pages 12, lines 5-8 and page 13, lines 1-4 of the brief on appeal that with particular reference to dependent claim 8, Pat does not describe downloading a program from a "storage medium read by the computing device". Instead, programs in the Pat system are downloaded from the Internet. See description of "browsing environment" of Figures 2 and 3.

In regards to point (C), examiner respectfully disagrees.

Column 3, lines 13-26, Pat discloses a magnetic disk drive and a optical disk drive for reading from and writing to a removable magnetic drive or disk drive. The drives provide nonvolatile storage of computer readable instructions, data structures, program modules and other data for the personal computer.

(D) The appellant argues on pages 13, lines 21-22 and page 14, lines 1-2 of the brief on appeal that With particular regard to dependent claim 19, Pat does not teach logic configured to "suggest an alternative selection in response to receipt of a user selection that identifies a software program the user already possesses". Applicant notes that no support for the rejection of claim 19 under Pat was provided by the Examiner.

In regards to point (D), examiner respectfully disagrees.

Pat was not used to reject features such as “suggest an alternative selection in response to receipt of a user selection that identifies a software program the user already possesses”.

(E) The appellant argues on page 14, lines 9-16 of the brief on appeal that regarding claim 25, the Pat system only queries the user for permission to load an update. Pat fails to teach or suggest “querying a user as to what the user wants to accomplish” or “providing software programs based upon the user responses”. That is, the Pat system simply asks the user for permission to load a system-detected update, with no inquiry as to “what the user wants to accomplish.” For at least the above reasons, Pat does not anticipate claim 25 or any of its dependents.

In regards to point (E), examiner respectfully disagrees.

Column 6, lines 15-20, Pat discloses the computer queries the user to determine if the user wants to load the new update now or later (i.e. determining if the user wants to load the new update now or later is equated to “what the user wants to accomplish”).

Column 11, lines 13-15, Pat discloses the installed software is performed when, in response to the querying step, and the user indicates a desire to load the new software update (i.e. the new update is based on the user's desire that is inherently equivalent to “providing the software program based upon the user responses”).

(F) The appellant argues on page 15, lines 1-10 of the brief on appeal that referring next to independent claim 29, Pat fails to teach or suggest "querying a user as to the needs of the user" for reasons described in the foregoing, or "suggesting software program based upon the user responses". Specifically, Pat's system makes no suggestions to the user based upon user responses. The only "suggestion" that Pat's system can be said to make is the implicit suggestion to load an update. Even using such a broad interpretation, however, that "suggestion" is not based upon a user response. Further, there is no inquiry in the system of Pat about the "needs of the user". The Pat system simply asks the user permission to load a system-detected update. For at least the above reasons, Pat does not anticipate claim 29 or any of its dependents.

In regards to point (F), examiner respectfully disagrees.

Column 6, lines 15-20, Pat discloses the computer queries the user to determine if the user wants to load the new update now, later or never. Then, if the user wants to load the new update (i.e. "software"), the program being downloaded is the "suggested software".

(G) The appellant argues on page 15, lines 17-21 and on page 16, lines 1-3 of the brief on appeal that Regarding claim 33, Pat fails to teach or suggest "determining tasks a user wishes to accomplish from responses provided by the user" or "installing software programs based upon the determination". Stated simply, Pat makes no determinations as to what a user wishes to accomplish, and therefore cannot install programs based upon that determination. The Pat system asks the user for permission

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to load a system-detected update, and discloses nothing about "determining tasks a user wishes to accomplish." For at least the above reasons, Pat does not anticipate claim 33 or any of its dependents.

In regards to point (G), examiner respectfully disagrees.

Column 6, lines 15-26, Pat discloses the computer queries the user to determine if the user wants to load the new update now, later or never. However, if the user wants to load the update now, the new update is loaded in step 118. Pat clearly teaches "determining task a user wishes to accomplish from responses provided by the user" or "installing software program (i.e. loading update) based upon determination".

(H) The appellant argues on page 16, lines 13-17 of the brief on appeal that as is identified above in reference to independent claim 1, Pat does not teach several of Applicant's explicit claim limitations. In that Bradford does not remedy the deficiencies of the Pat reference, Applicant respectfully submits that claim 2, which depends from claim 1, is allowable over the Pat/Bradford combination for at least the same reasons that claim 1 is allowable over Pat.

In regards to point (H), examiner respectfully disagrees.

This argument is already addressed in the above arguments.

(I) The appellant argues on page 16, lines 13-17 of the brief on appeal that as a further matter, Applicant asserts that there is no motivation to modify the Pat

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system/method in view of the Bradford reference. Bradford discloses a method and system for facilitating the refinement of data queries. Given that Pat is not conducting a data query and is instead only querying a user to as to whether to load an update now or later, no "refinement" of Pat's querying would be seen as desirable to a person having ordinary skill in the art. In view of this, the Examiner fails to state a proper obviousness rejection under 35 U.S.C. 103(a).

In regards to point (I), examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to modify the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, One would be motivated to modify the references to allow user feedback regarding relevancy of retrieved data.

(J) The appellant argues on page 17, lines 8-13 of the brief on appeal that as is identified above in reference to independent claims 1, 10, and 17, Pat does not teach several of Applicant's explicit claim limitations. In that Kroening does not remedy the deficiencies of the Pat reference, Applicant respectfully submits that dependent claims

6, 13, and 19 are allowable over Pat/Kroening for at least the same reasons that respective independent claims 1, 10, and 17 are allowable over Pat.

In regards to point (J), examiner respectfully disagrees.

This argument is already addressed in the above arguments.

(K) The appellant argues on page 17, lines 14-20 of the brief on appeal that turning to the merits of the rejection, Applicant notes that the Examiner states that Kroening teaches "an alternative method of selecting software to download". Applicant asserts that, even if that is true, Kroening still fails to teach "suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses", as in claim 6 (similar recitations contained in claims 13 and 19). Significantly, Kroening says nothing of such a process in column 7, line 51 to column 8, line 21, which were identified in the Office Action.

In regards to point (K), examiner respectfully disagrees.

Column 7, line 51 to column 8, line 21, Kroening discloses an alternative method of selecting components to download. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Kroening to provide suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses. One would be motivated to do so to allow the proper software update.

Furthermore, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention **where there is some teaching, suggestion, or motivation to do so** found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

(L) The appellant argues on page 18, lines 8-13 of the brief on appeal that in the outstanding Office Action, it is admitted that Pat does not teach such querying. However, the Office Action identifies the Himmel reference as providing the missing teaching, and further alleges that claims 3 and 21 would have been obvious under Pat in view of Himmel. Applicant asserts that Himmel neither teaches querying a user as to a contemplated use of a device, nor provides a teaching that is properly combinable with the Pat reference.

In regards to point (L), examiner respectfully disagrees.

Limitation such as "querying a user as to a contemplated use of a device" is not in the claims.

In response to applicant's argument that Himmel does not provide a teaching that is properly combinable with the Pat reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). In this case, One would be motivated to modify the references to allow user feedback regarding relevancy of retrieved data.

(M) The appellant argues on page 19, lines 5-9 of the brief on appeal that clearly, the above excerpt does not teach, ms is suggested in the Office Action, “querying the user as to how the user plans to use a peripheral device”. Instead, as before, the user is merely being asked for permission to do something, in this case whether to “accept and configure” a device. Nothing in the cited portion of the Himmel reference even suggests querying a user ms to “how” the user will use the device.

In regards to point (M), examiner respectfully disagrees. Column 9, lines 30-40, Himmel discloses querying whether the user has chosen to accept the peripheral device during state 232. If the user accepts the peripheral device, then in step 234, the bus driver notifies the operating system of the available peripheral device and the peripheral device is configured. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pat in view of Himmel to provide querying the user as to how the user plans to use a peripheral device. One would be motivated to do so to allow the peripheral device to process data properly.

Furthermore, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation to do so** found either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

(N) The appellant argues on page 19, lines 5-9 of the brief on appeal that clearly, the above excerpt does not teach, as is suggested in the Office Action, "querying the user as to how the user plans to use a peripheral device". Instead, as before, the user is merely being asked for permission to do something, in this case whether to "accept and configure" a device. Nothing in the cited portion of the Himmel reference even suggests querying a user as to "how" the user will use the device.

In regards to point (N), examiner respectfully disagrees.

In response to applicant's argument that Himmel does not provide a teaching that is properly combinable with the Pat reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, One would be motivated to do so to allow the peripheral device to process data properly.

(O) The appellant argues on page 19, lines 17-22 and on page 20, lines 1--2 of the brief on appeal that as is identified above in reference to independent claims 21,

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Pat and Himmel do not teach several of Applicant's explicit claim limitations. In that Bradford does not remedy the deficiencies of the Pat and Himmel references, Applicant respectfully submits that dependent claim 43 is allowable over Pat/Himmel/Bradford for at least the same reasons that independent claim 21 is allowable over Pat/Himmel.

In regards to point (O), examiner respectfully disagrees.


This argument is already addressed in the above arguments.

For the above reasons, it is respectfully submitted that the rejection should be sustained.

Respectfully Submitted,

El Hadji Sall

June 7, 2006


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100




SALEH NAJJAR
SUPERVISORY PATENT EXAMINER